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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,859	09/19/2001	Masaaki Ueno	101403-5	9900

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EXAMINER

DINH, KHANH Q

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/955,859

Applicant(s)

UENO, MASA AKI

Examiner

Khanh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/8/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 1-11 are presented for examination.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### **Claim Objections**

3. Claim 2 are objected to because of the following informalities.

Abbreviations, symbols, acronyms, functional designations, letter combinations code names, initializes, nicknames mnemonic devices, project names, alphabetical contractions and general slang must be positively defined and identified in the claims.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mousseau et al., US pat. No.6,438,585 in view of Shicrat, US pat. No.5,963,948.

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As to claim 1, Mousseau discloses an information output service system comprising:

a mail server (server 11 fig.2) connected to the Internet (32 fig.2);

a portable terminal (mobile computer 24 fig.2) and a plurality of fixed terminals (28 and 26 fig.2), wherein, the mail server has the function of storing and managing an e-mail transmitted via the Internet (see fig.2, abstract, col.9 line 48 to col.10 line 26).

wherein, the portable terminal (mobile computer 24 fig.2) has the function of designating an e-mail address and transmitting the e-mail and an attachment file together to the mail server (sending and processing email message including attachment from the mobile computer to fixed terminals, see col.8 lines 7-60 and col.10 lines 27-49); and wherein, the fixed terminals (28 and 26 fig.2), each of the fixed terminals comprising: input means for inputting personal information such as an e-mail address and an ID; mail extracting means (a redirection program for processing email data) for extracting the e-mail and its attachment file at the corresponding e-mail address from the mail server via the Internet based on the input personal information when the personal information is input via the input means and a printer for printing the contents of the extracted e-mail or the attachment file (using a redirection program to send the text of the E-mail to the remote device or to send the word processing document to a networked printer located near the user, see col.6 lines 28-55 and col.10 line 27 to col.11 line 57). Mousseau does not specifically disclose the use of computers installed at stores which the public. However, Shilcrat discloses the use of computers installed at

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stores which the public (customers can email queries and orders which are then handled by "personal shoppers", see col. 3 lines 10-32 and col.15 lines 8-50). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Shilcrat's teachings into the computer system of Mousseau to provide a variety of services to customers in public because it would have enabled users/customers to find their objects of interest and to query across stores in an interesting ways in the Internet-based-shopping online.

As to claim 2, Mousseau discloses the portable terminal is any one of a portable phone, a PHS, a notebook-sized personal computer, and a PDA (see col.11 line 46 to col.12 line 30).

As to claim 3, Mousseau discloses the attachment file of the e-mail is a document converted into digital data or an image such as a photograph (see col.11 line 46 to col.12 line 30 and col.17 line 31 to col.18 line 31).

As to claim 4, Mousseau discloses the portable terminal further has the function of photographing a still image with a digital camera and the function of transmitting a still image photographed by the digital camera to the mail server as the attachment file of the e-mail (see col.11 line 46 to col.12 line 30 and col.17 line 31 to col.18 line 31).

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As to claim 5, Mousseau discloses that every time a still image is photographed by the digital camera, the still image photographed by the digital camera is immediately transmitted to the mail server as the attachment file of the e-mail (see col.11 line 46 to col.12 line 30 and col.15 lines 14-65).

As to claim 6, Mousseau discloses that the portable terminal (mobile device) is provided with an image memory capable of storing a plurality of still images photographed by the digital camera in individual files; and wherein, when a predetermined number of the still images are stored in the image memory, the predetermined number of still images are transmitted together at one time to the mail server as the attachment file of the e-mail (see fig.7, col.15 lines 14-65 and col.16 line 43 to col.17 line 30).

As to claim 7, Mousseau discloses that the portable terminal further has the function of photographing moving images with a digital camera and the function of transmitting moving images photographed by the digital camera to the mail server as the attachment file of the e-mail (see fig.7, col.15 lines 14-65 and col.16 line 43 to col.17 line 30).

As to claim 8, Mousseau discloses that the moving images photographed by the digital camera are continuously transmitted to the mail server as the attachment file of the e-mail while the digital camera is performing the operation of photographing the moving images (see fig.7, col.11 line 46 to col.12 line 30 and col.15 lines 14-65).

As to claims 9 and 10, Mousseau does not specifically disclose each of the fixed terminals further comprising a data recorder for recording the contents of the e-mail or the attachment file on a recording media including one of a digital videotape, a CD-R, and a DVD and a Web site for obtaining an account for using the mail server, wherein, when obtaining the account at the Web site, the user is charged for the use of this system. However, Shilcrat discloses each of the fixed terminals further comprising a data recorder for recording the contents of the e-mail or the attachment file on a recording media including one of a digital videotape, a CD-R, and a DVD and a Web site for obtaining an account for using the mail server, wherein, when obtaining the account at the Web site, the user is charged for the use of this system (allowing users to do audio recordings when shopping online in public, see col. 19 lines 19-64 and col.35 lines 30-63). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Shilcrat's teachings into the computer system of Mousseau to provide a variety of services to customers in public because it would have provided users/customers an easy access way to customize their objects of interest and to query across stores in an interesting ways in the Internet-based-shopping online.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mousseau and Shicrat as applied to claim 1 above, and further in view of Ballard, US pat. No.6,182,050.

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Mousseau and Shicrat's teachings still applied as in item 4 above. Neither Mousseau nor Shicrat discloses a display, and wherein, an advertisement is displayed on the display of the fixed terminal when the fixed terminal is idle. However, Ballard discloses a display, and wherein, an advertisement is displayed on the display of the fixed terminal when the fixed terminal is idle (displaying an advertisement on the end user computer while the end user is off-line and the computer is idle, see fig.3, col.6 lines 25-63). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Ballard's teachings into the computer system of Mousseau to provide an advertisement of services to customers because it would have enabled users to send advertisements which have an affinity request range encompassing the end user's affinity level for best matching consumer/user and advertisements online.

***Other prior art cited***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Theimer et al, US pat. No.5,555,376.
- b. Theimer et al, US pat. No.5,493,692.
- c. Taniguchi et al, US pat. No.6,801,962.



**Conclusion**

5. Claims 1-11 are rejected.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (703) 272-3939. The fax phone number for this group is (703) 872-9306.

*A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U. S. C . Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Khanh', with a stylized flourish extending from the end.

Khanh Dinh  
Patent Examiner  
Art Unit 2151  
1/22/2005